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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,139	03/06/2002	William D. Tandy	4333.1US (99-0257.1)	9714
24247	7590	03/31/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/092,139	Applicant(s) TANDY ET AL. 	
	Examiner Victor S Chang	Art Unit 1771	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-24.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

NOTE

1. With respect to the newly submitted replacement sheet for Fig. 5, the Examiner notes that while disclosure relating to marking tape 1 (an article) is found throughout the Specification, no where can the newly proposed element 1 be found. Clarification is requested. Further, the Examiner repeats (see Paper No. 123103, section 5) that element 2B (see paragraph [0049]) is still absent from any of the drawings.
2. Applicants' Remarks states that a copy of Information Disclosure Statement (IDS) filed on July 17, 2002 along with a copy of the return receipt date-stamped postcard has been attached to the Amendment filed 3/8/2004. However, a copy of aforementioned IDS is not available to the Examiner at the time of this Advisory action.
3. With respect to the rejection of claims 1-24 under 35 U.S.C. 112, first paragraph, Applicants argue that "These adhesive properties, suitable for use in carrier-tape or marking-tape applications, are well known and commonly used by persons skilled in the art of semiconductor manufacturing" (Remarks, page 8), the Examiner repeats (see Paper No. 123103, section 6) that in claim 1, the lacking of a suitable composition and properties of the "second adhesive" renders the instantly claimed invention unduly broad and in excess of provided enablement, for example, the "second adhesive" could encompass the "first outermost adhesive", and forms one single layer. Further, it should be noted that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. See *In re Van Geuns*, 988 f.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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4. With respect to the substantially completely rewritten claims 2-6, 10-14 and 18-22, that appears to address the “new matter” issues, the Examiner notes that such amendments clearly raise new issues that would require further consideration and/or search.

5. With respect to Applicants’ argument that “there is clearly no suggestion or motivation in Weng et al. to modify the reference such that the tape disclosed therein comprises radiation-curable components” (Remarks, page 17, first full paragraph), the Examiner repeats (see Paper No. 123103, page 6) that Weng teaches a laser mark tape of polymeric material and a method of marking the tape with an identification mark by a high-intensity energy beam (column 2, lines 20-21), which clearly reads on the instantly claimed element of a first adhesive layer of a mixture of electromagnetic radiation-curable components, and Weng expressly teaches that one of the suitable materials is a polymeric based material which can be easily patterned by high intensity energy beam such as UV light or laser (column 4, lines 28-33), Applicants’ argument to the contrary notwithstanding.

6. With respect to Applicants’ argument that “the instantly claimed invention is very far from being essentially the same as the invention disclosed by Weng et al. ... in Weng et al., the mark is formed in the semiconductor surface itself using an etchant ... No etchant is used to form a mark in the surface of semiconductor surface in the instantly claimed invention ...” (Remarks, page 18, last full paragraph), the Examiner notes that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or

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chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection.

See MPEP § 2113.

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zinker